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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,907	03/22/2004	Michael I. Rosenfelt	53086-00703USPT	2039
24238	7590	08/03/2006	[REDACTED]	EXAMINER
JENKENS & GILCHRIST 1401 MCKINNEY SUITE 2600 HOUSTON, TX 77010			[REDACTED]	LEE, JUSTIN YE
			[REDACTED]	ART UNIT
				PAPER NUMBER
			2617	

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/805,907	ROSENFELT ET AL.	
	Examiner	Art Unit	
	Emeka D. Iwuchukwu	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 May 2006.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19,21-23,25-34,36,38 and 39 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-19,21-23,25-34,36,38 and 39 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/21/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Art Unit Notice

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Information Disclosure Statement

2. The information disclosure statements (IDS) submitted on 02/17/2006 and 06/21/2006 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 405,406.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Response to Amendment

4. This Office Action is in response to the amendment filed on 05/12/2006.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claim 18** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 recites the limitation "from said pre-specified alternate location" in Line 7.

There is insufficient antecedent basis for this limitation in the claim. The office shall interpret the claim to read "from an alternate location".

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-10&25-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication 2004/0153713 A1 to Aboel-Nil et al. (*hereinafter Aboel-Nil*) in view of U.S. Patent Publication 2005/0009502 A1 to Little et al. (*hereinafter Little*).

With respect to claims 1&25, Aboel-Nil teaches the method and system for providing backup electronic messaging services to devices during outages, comprising: sending email messages from a primary email system to a user's device (paragraph 22); when said primary email system is unavailable, redirecting said email messages from said primary email system to a secondary email system and from said secondary email system to said user's device (paragraphs 22,26); notifying said users that said email messages are available on said user's device through said secondary email system at such time as said redirection of said email messages has been implemented (paragraphs 22,27); at such time as said primary email system becomes unavailable, the users of said devices are notified that said primary email system is unavailable (paragraph 15); at such time as said primary email service becomes available, redirecting said email messages from said secondary email system to said primary email system and from said primary email system to said user's devices (paragraphs 22,29,31); notifying said users that said email messages are available on said user's devices through said primary email system at such time as said redirection of said email messages has been implemented (paragraphs 22,29); and synchronizing said email messages received on said secondary email system while said primary email system was unavailable with the messages in said primary email system (paragraphs 22,30). Aboel-Nil fails to expressly disclose that said user's device is a wireless device.

In the same field of endeavor, Little teaches a similar method and system wherein the device is a wireless device (paragraph 10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a wireless device for the advantage of compatibility with a wider variety and larger number of customer devices.

With respect to claims 2&26, Aboel-Nil teaches the method and system of claims 1&25, wherein said primary email system is located remotely from said secondary email system and is interconnected to said secondary email system through the Internet (paragraph 24).

With respect to claims 3&27, Aboel-Nil teaches the method and system of claims 1&25, wherein the determination of when said primary email system is unavailable is performed manually by assessing whether an error message has been received indicating an inability to deliver an email message to said primary email system (paragraph 25).

With respect to claims 4,5,28&29, Aboel-Nil teaches the method and system of claims 1&25, wherein said email messages to all email addresses on said primary email system are automatically redirected to said secondary email system at any time any (paragraph 26), and after some, but less than all (paragraph 26), of said email messages on said primary system are unavailable.

With respect to claims 6&30, Aboel-Nil teaches the method and system of claims 1&25, wherein said step of notifying said user that said email messages are available on said secondary email system further includes an automated delivery of a preexisting notification email message to an alternate email address for said users (paragraph 27).

With respect to claims 7&31, Aboel-Nil teaches the method and system of claims 1&25, wherein assessing a time at which said primary email system is available includes

periodically pinging email addresses on said primary email system and evaluating whether a response is received from said email addresses (paragraph 28).

With respect to claims 8&32, Aboel-Nil teaches the method and system of claims 1&25, wherein said notification of said user that said email messages are again available on said primary email system consists of the automated delivery of a preexisting notification email message to an alternate email address for said user (paragraph 29).

With respect to claims 9&33, Aboel-Nil teaches the method and system of claims 1&25, wherein an ability to redirect said email messages from said primary email system to said secondary email system is password protected (paragraph 26).

With respect to claims 10&34, Aboel-Nil teaches the method and system of claims 1&25, wherein one or more of said wireless devices is selected from the group consisting of personal digital assistant devices, cell phones and pagers (paragraph 27).

10. **Claims 11&16** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,857,009 to Ferreria et al. (*hereinafter Ferreria*) in view of U.S. Patent Publication 2005/0009502 A1 to Little et al. (*hereinafter Little*).

Ferreria teaches the method for intercepting and redirecting email messages to devices, comprising: intercepting email messages responsive to an outage of the company's primary email system (Col 20 Lines 25-28), prior to said email messages passing through a company's firewall, wherein said step is performed during said outage of the primary email system; redirecting said email messages to a pre-specified alternate location and delivering said email messages from said pre-specified alternate location to said devices (Col 20 Lines 14-15,25-28,38-48; Fig 20) and intercepting responsive to detection of an outage of a primary email

system, email messages intended for the primary email system within an email application through the use of an event sink desired to inspect email message traffic and redirecting said email messages to an alternate location (Col 19 Lines 15-24; Col 20 Lines 9-17). Ferreria fails to expressly disclose that said device is a wireless device.

In the same field of endeavor, Little teaches a similar method and system wherein the device is a wireless device (paragraph 10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a wireless device for the advantage of compatibility with a wider variety and larger number of customer devices.

11. **Claims 12,14,36&38** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication 2005/0009502 A1 to Little et al. (*hereinafter Little*) in view of U.S. Patent No. 6,857,009 to Ferreria et al. (*hereinafter Ferreria*).

Little teaches the method and system for intercepting and redirecting email messages to wireless devices, comprising: a customer mail stream service or Internet mail connector for intercepting email messages after said email messages pass through a company's firewall, but before said email messages enter said primary email system, wherein said step of intercepting is performed during said outage of the primary email system; redirecting said email messages to a pre-specified alternate location (paragraph 35); and after said email messages enter said primary email system, but before said email messages leave the Internet mail connector and redirecting said email messages to a pre-specified alternate location (paragraph 35); and delivering said email messages from said pre-specified alternate location to said wireless devices (paragraph 35).

Little fails to expressly disclose the intercepting method occurring responsive to detection of an outage of a primary email system.

In the same field of endeavor, Ferreria teaches a similar method and system for intercepting and redirecting email messages to wireless devices responsive to an outage of the company's primary email system (Col 20 Lines 25-30).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to intercept and redirect said email messages responsive to an outage of the company's primary email system, so that a user can still receive email messages when the user moves to a remote location and access to the user's primary email system is unavailable due to network traffic or location of the primary system as taught by Ferreria (Col 20 Lines 25-30).

12. **Claim 13** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication 2005/0009502 A1 to Little et al. (*hereinafter Little*) in view of U.S. Patent No. 6,857,009 to Ferreria et al. (*hereinafter Ferreria*) further in view of U.S. Patent Publication 2005/0120229 A1 to Lahti.

Little teaches the method and system of claims 12. Little fails to expressly disclose that the method operates integrally with the company's anti-virus or anti-spam application.

In the same field of endeavor, Lahti teaches a similar method that operates integrally with the company's anti-virus or anti-spam application.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the method operate integrally with the company's anti-virus or anti-spam application so the firewall incorporated into the web servers can be used to authenticate and

authorize the HTTP connections, and to prevent unauthorized access to the anti-virus applications as taught by Lahti (paragraph 30).

13. **Claims 15&39** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication 2005/0102074 A1 to Kolls in view of U.S. Patent No. 6,957,248 to Quine et al. (*hereinafter Quine*).

Kolls teaches the method and system for intercepting and redirecting email messages to wireless devices, comprising: intercepting, responsive to detection of an outage of a primary email system, email messages within the primary email system on a real-time basis, wherein said step of intercepting is performed during said outage of the primary email system; redirecting said email messages to an alternate location; and delivering said email messages from said pre-specified alternate location to said wireless devices (paragraph 393). Kolls fails to specifically mention the email messages are directed to non-functioning addresses.

In the same field of endeavor, Quine teaches a similar method and system wherein the email messages are directed to non-functioning addresses (Col 10 Lines 23-42).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method or system for non-functioning addresses for dynamic email forwarding as taught by Quine (Col 10 Lines 23-42).

14. **Claims 17&18** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,557,036 to Kavacheri et al. (*hereinafter Kavacheri*) in view of U.S. Patent Publication 2004/0235503 A1 to Koponen et al. (*hereinafter Koponen*).

With respect to claim 17, Kavacheri teaches the method for intercepting and redirecting email messages to wireless devices, comprising, redirecting responsive to detection of an outage

of a primary email system, email messages intended to be delivered to said primary email system to an SMTP host (Col 5 Lines 18-27). Kavacheri fails to expressly disclose the email messages have a low priority designation.

In the same field of endeavor, Koponen teaches a similar method that redirects email messages with a lower priority designation (paragraphs 22,32).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to redirect email messages with a lower priority designation so as to save space on the primary email system's storage device.

With respect to claim 18, Kavacheri teaches the method for intercepting and redirecting email messages to wireless devices, comprising: changing a domain name system designation of a primary email system responsive to detection of an outage of a primary email system; and directing inbound email messages to an alternate facility (Col 2 Lines 63-67; Col 5 Lines 18-27; Col 6 Lines 8-16; Col 8 Lines 28-39). Kavacheri fails to expressly disclose delivering said email messages from an alternate location to wireless devices.

In the same field of endeavor, Koponen teaches a similar method and system including delivering email messages from a pre-specified alternate location to wireless devices (paragraph 32).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include delivery to wireless devices for the advantage of having a more versatile method and system that can accommodate the ever-growing number of wireless customers.

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15. Claims 19&21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,557,036 to Kavacheri et al. (*hereinafter Kavacheri*) in view of U.S. Patent Publication 2004/0019695 A1 to Fellenstein et al. (*hereinafter Fellenstein*).

With respect to claim 19, Kavacheri teaches a method of delivering backup messages to wireless devices, comprising: delivering email messages responsive to detection of an outage of a primary email system; wherein said step of delivering is performed during said outage of said primary path for delivering said email messages (Col 5 Lines 18-27). Kavacheri fails to expressly disclose maintaining a mapping of alternate email addresses of the wireless devices.

In the same field of endeavor, Fellenstein teaches a similar method including maintaining a mapping of alternate email addresses of the wireless devices; and delivering via said alternate email address, the email messages to said wireless devices (paragraphs 49-51; Fig 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to maintain a mapping of alternate email addresses and deliver via said alternate email address if the user is unable to receive the message through its primary email address as taught by Fellenstein (paragraphs 48-51).

With respect to claim 21-23, Kavacheri in view of Fellenstein teaches the method according to claim 19, further comprising: pulling messages from a mailbox within a secondary email system to a wireless device wherein said mailbox is a pop3 and an imap4 mailbox (Kavacheri, Col 8 Lines 4-18).

16. **Claim 19** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication 2004/0019695 A1 to Fellenstein et al. (*hereinafter Fellenstein*) in view of U.S. Patent No. 6,857,009 to Ferreria et al. (*hereinafter Ferreria*).

Fellenstein teaches a method of delivering backup messages to wireless devices, comprising: maintaining a mapping of alternate email addresses of the wireless devices; and delivering, via said alternate email address, the email messages to said wireless device (paragraphs 49-51; Fig 3). Fellenstein fails to expressly disclose the delivery is responsive to detection of an outage of a primary email system.

In the same field of endeavor, Ferreria teaches a similar method and system for intercepting and redirecting email messages to wireless devices responsive to an outage of the company's primary email system (Col 20 Lines 25-30).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to intercept and redirect said email messages responsive to an outage of the company's primary email system, so that a user can still receive email messages when the user moves to a remote location and access to the user's primary email system is unavailable due to network traffic or location of the primary system as taught by Ferreria (Col 20 Lines 25-30).

Response to Arguments

17. Applicant's arguments filed with respect to claims 1-10, 19&25-34 with respect to the *wireless* device have been considered but are moot in view of the new grounds of rejection.

Applicant's arguments filed with respect to claims 11, 16, 35 and 40 have been fully considered but they are not persuasive.

Applicant argues that Ferreria fails to disclose intercepting email messages responsive to detection of an *outage* of a primary email system in the last paragraph of page 13 of the response. Applicant also makes similar allegations throughout the full body of the response

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regarding the Little, Kavacheri, Koponen, Kolls, Quine and Lahti references all of which are addressed as follows.

The Examiner respectfully disagrees. An outage is an interruption of service, and since the references disclose the limitations occurring during an outage (interruption of service) they read on the claims.

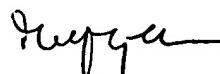
Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emeka D. Iwuchukwu whose telephone number is (571) 272-5512. The examiner can normally be reached on M-F (9AM - 5.30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on (571) 272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EDI


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PRIMARY EXAMINER